

**REMARKS**

**I. Status of Claims**

Claims 1-186 are pending in this application. Claims 10-12, 20-28, and 60-186 have been withdrawn from consideration by the Examiner. Claims 1-9, 13-19, and 29-59 have been examined.

**II. Nonstatutory Double Patenting Rejection**

Claims 1-9, 13-19, and 29-59 continue to be provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-85, 152, and 153 of U.S. Application No. 09/820,481. *Final Office Action* at p. 2.

Applicants respectfully disagree and traverse this rejection. Accordingly, Applicants respectfully request that the rejection be held in abeyance until allowable subject matter is indicated in this application.

**III. Rejection under 35 U.S.C. §103**

Claims 1-9, 13-19, and 29-59 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,235,298 ("Naser") in view of U.S. Patent No. 5,688,930 ("Bertho"). *Final Office Action* at pp. 2-3. Applicants respectfully traverse this rejection.

Two of the basic criteria an Examiner must demonstrate in order to establish a prima facie case of obviousness are (1) that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and

(2) that there is a reasonable expectation of success in making the proposed modification. See M.P.E.P. §2143. Applicants respectfully submit that neither of these two criteria has been satisfied.

The Examiner asserts that the ingredients of Naser and Bertho can be combined and states that the combination does not require “the replacement of polysaccharide gum of Naser with the alkyl pentosides of Bertho and instead teaches addition of alkyl pentosides of Bertho to the composition (containing the amphoteric surfactant) of [Naser].” *Final Office Action* at p. 3. However, the Examiner has failed to provide the requisite motivation for this addition and is improperly using hindsight to combine Naser and Bertho. The Examiner further states in the Advisory Action that the claims do not exclude polysaccharide gum, as taught by Naser. *Advisory Action* at continuation sheet.

Although Applicants note that Naser teaches the use of surfactants, Applicants respectfully submit that there is no teaching or motivation in the cited references to add the alkyl pentoside of Bertho to Naser’s compositions. Naser’s compositions comprise a water-in-oil-in-water ( $W_1$ -O- $W_2$ ) multiple emulsion. *Naser* at col. 2, lines 15-16.  $W_1$  is an internal aqueous phase comprising a solute and optionally a surfactant and/or a first topically active compound. *Id.* at col. 2, lines 17-18 and col. 4, lines 51-54. O is the oil phase surrounding the internal aqueous phase,  $W_1$ , and comprises an oil and a low HLB emulsifier. *Id.* at col. 2, lines 19-22.  $W_2$  is an external aqueous isotropic phase surrounding  $W_1$ -O. *Id.* at col. 2, lines 23-24. The external aqueous phase,  $W_2$ , does not contact the internal aqueous phase,  $W_1$ , due to the intermediary oil phase, O. *Id.* at col.

4, lines 35-37.  $W_2$  comprises a surfactant, a second topically effective compound, and a stabilizing natural gum polymer. *Id.* at col. 15, lines 26-32.

The surfactants taught by Naser include:

1. The low HLB emulsifier of the oils phase, O. The low HLB emulsifier can be a silicon-free or silicone based surfactant having an HLB value less than about 10. *Id.* at col. 13, lines 1-3. Exemplary silicon-free surfactants include certain polyoxyethylene ethers or polyethylene glycol ethers, where a preferred silicon-free surfactant is PEG 30 dipolyhydroxystearate. *Id.* at col. 13, lines 30-35 and 61-62. The surfactant phase can also comprise an oil-soluble polymeric surfactant. *Id.* at col. 14, lines 39-40.

2. Surfactants of  $W_2$ .  $W_2$  comprises a “relatively high level of surfactant(s) that form an isotropic phase ... [and] contains all non-amido anionic or all amphoteric surfactant, or combinations of the two.” *Id.* at col. 15, lines

3. Optional surfactant in  $W_1$ . *Id.* at col. 2, line 18 and col. 10, lines 44-47. These surfactants can be “any of the surfactants discussed in connection with the  $W_2$  phase.” *Id.* at col. 10, lines 46-47.

While it is true that Naser teaches many different types of surfactants, none of these remotely describe the alkyl pentoside of Bertho. Bertho does not teach alkyl pentoside as being a low HLB emulsifier, much less a polyoxyethylene ether or polyethylene glycol ether as taught by Naser. Moreover, an alkyl pentoside is neither an oil-soluble polymeric surfactant, a non-amido anionic, nor an amphoteric surfactant, as required by Naser. Naser also teaches several requirements for the emulsion formulation, as noted by Applicants in the previous Reply. Thus, an alkyl pentoside is a

seemingly random choice since the references fail to teach that it would serve a useful purpose in Naser's compositions.

Applicants do not contest that an alkyl pentoside can be added to Naser's compositions. However, whether alkyl pentosides can be added is not the standard for establishing a *prima facie* case of obviousness. M.P.E.P. §2143.01 ("Fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness.") Instead, the prior art must suggest "the desirability of the combination. *Id.* This is not shown here. Naser teaches the desirability of only certain surfactants listed above; alkyl pentosides are not among them. Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness.

Finally, Applicants respectfully submit that the references do not provide a reasonable expectation of success that adding the alkyl pentosides of Bertho to Naser's compositions would satisfy the rigid requirements set forth by Naser. Bertho merely provides a broad suggestion that anionic, cationic or non-ionic surfactants can be combined with the alkyl pentoside mixture without teaching the properties resulting from the combination.

Accordingly, there is no motivation to combine the references and no expectation of success. For at least the foregoing reasons, Applicants respectfully request the withdrawal of this rejection.

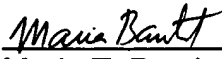
#### **IV. Conclusion**

In view of the foregoing remarks, Applicants respectfully request the reconsideration and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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